



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/588,495 | 06/07/2000 | Akihito Mochizuki | 1232-4423US1 | 9609 |
| 27123 | 7590 | 06/01/2006 | EXAMINER | |
| MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | BAROT, BHARAT | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2155 | |

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/588,495

Applicant(s)

MOCHIZUKI, AKIHITO

Examiner

Bharat N. Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12,15,16,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12,15,16,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO REQUEST FOR CONTINUED EXAMINATION (RCE)

1. Claims 8-12, 15-16, and 21-22 remain for further examination.

The new grounds of rejection

2. Applicants' arguments and amendments with respect to claims 8, 15, and 16 and request for continued examination (RCE) filed on February 28, 2006 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8-12, 15-16, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higley (U.S. Patent No. 5,790,793).

Art Unit: 2155

5. As to claim 8, Higley discloses a data communication apparatus (figures 3 and 5) comprising: a first transmission unit (502), arranged to transmit a URL representing the existence of additional information to a transmission destination (user) (figure 4; and column 5 lines 10-18); a reception unit (500), arranged to receive a reply from the transmission destination for the URL transmitted by the first transmission unit (figure 4; and column 5 lines 18-26); a generating unit (506, 510), arranged to generate a markup language file including the additional information to be accessed by the transmission destination (figure 4; and column 5 line 54 to column 6 line 8); a second transmission unit (504), arranged to transmit the markup language file including the additional information based on the reply received by the reception unit (figure 4; and column 5 line 27 to column 6 line 8)/(figure 5; and column 6 line 16 to column 7 line 37); a printing unit (1010), arranged to print an image; and a control unit (1002, 1011), arranged to control the transmission by the second transmission unit or the printing by the printing unit (figure 10; and column 8 lines 23-49).

However, Higley does not explicitly disclose that the printing unit print an image in accordance with the additional image and the control unit control the transmission by the second transmission unit or the printing by the printing unit based on the reply received by the reception unit, but Higley explicitly discloses a printing unit (1010), arranged to print an image; and a control unit (1002, 1011), arranged to control the transmission by the second transmission unit or the printing by the printing unit (figure 10; and column 8 lines 23-49); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Higley by incorporating the

special condition for printing an image and controlling transmission unit and printing unit based on the reply received by the reception unit with a data communication apparatus of Higley because it would have minimized the system bottleneck and improved the system, network, and user efficiency.

6. As to claims 9-10, Higley discloses that the second transmission unit transmits the additional information in a manner different from that of the first transmission unit and to a terminal (browser) different from a terminal (email application) to which the data was transmitted by the first transmission unit (figure 5; and column 6 line 16 to column 7 line 37).

7. As to claim 11, Higley discloses a link to a location of the additional information is set in the URL transmitted by the first transmission unit (figures 4-5; column 5 lines 1-18; and column 6 line 64 to column 7 line 1).

8. As to claim 12, Higley discloses a processed content based on the reply received by the reception unit is further transmitted to the transmission destination (figures 3-5; column 5 line 27 to column 6 line 8; and column 6 lines 16-63).

9. As to claims 15-16, they are also rejected for the same reasons set forth to rejecting claim 8 above, since claim 15 is merely a method of operation and claim 16 is merely a computer readable medium for the apparatus defined in the apparatus claim 8.

Art Unit: 2155

10. As to claims 21-22, Higley teaches an input unit arranged to input image data, wherein the additional information is the image data input by the input unit; and a storage unit stores the image data in a plurality of forms respective different image quality, wherein the second transmission unit transmits the image data each of the plurality of forms (figures 3, 5, and 6-9; column 4 lines 46-67; and column 6 line 16 to column 8 line 22).

Response to Arguments

11. Applicant's arguments have been fully considered. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

Contact Information

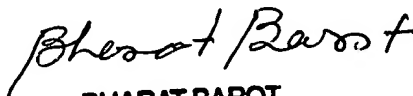
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

Patent Examiner Bharat Barot

Art Unit 2155

May 22, 2006


BHARAT BAROT
PRIMARY EXAMINER